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Olson & Hierl LTD
36th Floor
20 North Wacker Drive
Chicago, IL 60606

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580,145

Applicant(s)

UNDERWOOD ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to the request for continued examination filed on March 2, 2004 (Paper No. 8). Amendments to claims 6 and 8 and addition of new claims 10-14 have been entered. In view of the amendments rejection of claims 6-8 under 35 USC § 112-second paragraph made in the final rejection (Paper No. 4) are withdrawn by the Examiner. Claims 1-14 are pending in the application and have been examined. The rejections are stated below.

Claim Rejections - 35 USC § 101

2. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-9 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office has taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001)(Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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4. Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 10 and 13, there is no antecedent basis for "the buyer codes" recited in steps (c) and a (2) respectively of these claims. Steps (g) and (b) of claims 10 and 13 respectively, cite the limitation "if the asset is unsold upon conclusion of the ... auction". However there is no cited step of "selling the asset" prior to this limitation. Also "tier auction" in claim 13 step a (5) is understood by the examiner to mean "tiered auction". Appropriate clarification/correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al (US Patent 5,924,082) in view of Godin et al (US Patent 5,890,138).

With reference to claims 1 and 3 Silverman discloses a method comprising the steps of:

(a) receiving seller input comprising a first asset profile code for the asset, wherein the first asset profile code comprises at least one community restriction which must be met by a buyer before the buyer is authorized to purchase the asset; (b) retrieving information provided by at least one buyer, the information comprising a buyer profile code; (c) comparing the buyer profile code of the at least one buyer with the first asset profile code to determine whether the

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buyer profile code of the at least one buyer matches the first asset profile code; (d) if the buyer profile code of the at least one buyer matches the first asset profile code, performing the steps comprising: (1) displaying the asset to the at least one buyer; (2) offering the asset for sale to the at least one buyer; (3) accepting bids on the asset from the at least one buyer; (See Silverman Column 4 lines 4-27 and Claim 9). The minimum ranking is a community restriction, which must be met by a buyer before the buyer is authorized to purchase the asset; displaying potential transaction includes displaying the asset to the buyer and the trading includes the steps of offering the asset for sale and accepting bids on the asset. Ranking is an art recognized equivalent profile code and matching the ranking implies matching the profile codes.

Silverman does not explicitly teach the steps of concluding an auction conducted on the Internet at least upon expiration of a seller-defined time period for completing the auction and determining a highest bid from the bids accepted during the auction.

Godin teaches the steps of concluding the auction at least upon expiration of a seller-defined time period for completing the auction (See Godin Column 3 lines 31-38) and determining a highest bid from the bids accepted during the auction (See Godin Column 1 lines 18-20) wherein the auction is conducted on the Internet (See Godin Column 3 lines 14-21).

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the teachings of Godin to the invention of Silverman. The combination of the disclosures taken as a whole suggests that both the seller would have been able to maximize his proceeds by selling to the highest bidder.

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With reference to claim 2, Silverman teaches a method of claim 1 wherein the first asset profile code further comprises at least one asset restriction, which must be met by a buyer before the buyer is authorized to purchase the asset (See Silverman Column 4 lines 20-23).

7. Claims 4-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al (US Patent 5,924,082) in view of Godin et al (US Patent 5,890,138) and further in view of Odom et al (US Patent 6,058,379)

With reference to claims 4 and 5, Silverman and Godin combined teach a method of claim 1 as discussed above.

Silverman and Godin combined do not explicitly teach the steps of assigning a seller-defined strike price to the asset and concluding the auction occurs if the seller-defined strike price is met.

Odom teaches the steps of assigning a seller-defined strike price to the asset and concluding the auction occurs if the seller-defined strike price is met (See Odom Column 3 lines 43-4, 57-58 and Column 8 lines 21-24) Acceptable bid is interpreted to include a strike price and setting the exchange parameters is interpreted to include defining acceptable bids.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the disclosures of Odom and Godin to the teachings of Silverman. The combination of the disclosures taken as a whole suggests that it would help the seller sell the asset only if the bid is acceptable to the seller.

With reference to claims 6 and 7, Odom, Godin and Silverman combined teach a method of claim 4 as discussed above including the steps of: comparing the highest bid with the strike price, whereby if the highest bid is less than the strike price, there is no winner; a

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second asset profile code comprises at least one community restriction, and the second asset profile code is different from the first asset profile code (See Silverman Column 4 lines 41-47), retrieving information provided by at least one buyer, the information comprising a buyer profile code; comparing the buyer profile code of the at least one buyer with a second asset profile code to determine whether the buyer profile code of the at least one buyer matches the second asset profile code; if the buyer profile code of the at least one buyer matches the second asset profile code performing the steps comprising: displaying the asset to the at least one buyer; offering the asset for sale to the at least one buyer, accepting bids on the asset from the at least one buyer; if either the seller-defined time period for completing the auction has expired or the seller-defined strike price is met, concluding the auction; and determining a highest bid from the bids accepted during the auction (See discussion of claims 1, 4 and 5 above; and wherein the second asset profile code further comprises at least one asset restriction, which must be met by a buyer before the buyer is authorized to purchase the asset (See Silverman Column 4 lines 41-47).

Odom further teaches the step of assigning the asset a second asset profile code (See Odom Column 5 lines 27-34).

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the disclosures of Odom and Godin to the teachings of Silverman. The combination of the disclosures taken as a whole suggests that it would help the seller modify existing listing and sell the asset only if the bid is acceptable to the seller.

With reference to claims 8 and 9 the applicant is respectfully directed to the discussion of claims 6 and 7 above.

With reference to claims 10-13 the applicant is respectfully directed to the discussion of claims 6 and 7 above.

With reference to claim 14 the applicant is respectfully directed to the discussion of claims 6 and 7 above. The features in this claim correspond to a third tier, in which there are no asset restrictions. These features are inherent in the disclosures of Godin and Odom.

Response to Arguments

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. pre-qualification of buyers to gain access to bid on assets) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the Silverman reference fails to disclose any sort of profile code, the Examiner wishes to point out that ranking is an art recognized equivalent profile code. Silverman teaches ranking and hence Silverman teaches profile code. Also it is not necessary for traders to have prior experience with other potential traders so as to create ranking. In fact the identity of the parties to the transaction is not revealed until just before or at the time a deal has been struck (See Silverman Column 4 lines 9-11).

In response to applicant's argument that Silverman is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977

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F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Silverman is concerned with the problem of pre-qualifying the parties to the transaction before displaying the details. The current invention is also concerned with pre-qualifying buyers before they are displayed the details. Hence Silverman is analogous art.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine as provided in the rejections would have been obvious to one with ordinary skill in the art.

Applicant's other arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft to the Patent Office is (703) 872-9306. Any inquiry of a general nature

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or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian

April 28, 2004

Richard Weisberger
Primary Examiner